

AUG 16 2004

OFFICIAL

**FROMMER LAWRENCE & HAUG LLP**

745 Fifth Avenue  
New York, New York 10151  
Telephone: (212) 588-0800  
Facsimile: (212) 588-0500  
E-mail: Firm@flhlaw.com

**FACSIMILE COVER LETTER**

**To:** Examiner Stacy B. Chen  
**Firm:** United States Patent and Trademark Office, Group Art Unit 1648  
**Facsimile:** 703 872 9306  
**From:** Thomas J. Kowalski  
**Date:** August 16, 2004  
**Re:** USSN 09/943,443  
**Number of Pages:** 4  
(including cover page)

---

If you do not receive all pages or are unable to read the transmission, please call and ask for Angela (Ext. 2198).

---

**CONFIDENTIALITY NOTICE**

The documents accompanying this transmission contain confidential information intended for a specific individual and purpose. The information is private, and is legally protected by law. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution, or the taking of any action in reliance on the contents of this facsimile is strictly prohibited.

00211944

OFFICIAL 002

PATENT  
454313-2220.1**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Jean-Christophe AUDONNET et al.  
Serial No. : 09/943,443  
Filed : August 30, 2001  
For : FELINE POLYNUCLEOTIDE VACCINE FORMULA  
Art Unit : 1642  
Examiner : Stacy Brown Chen

RECEIVED  
CENTRAL FAX CENTER

AUG 16 2004

745 Fifth Avenue  
New York, New York 10151**FACSIMILE**

I hereby certify that this paper is being facsimile transmitted to the  
Patent and Trademark Office on the date shown below.

Angela M. Collison, Reg. No. 51,107

Type or print name of  
person signing certification



Signature

August 16, 2004

Date of Signature

**RESPONSE TO RESTRICTION REQUIREMENT  
AND REQUEST FOR EXTENSION OF TIME**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action containing a restriction requirement mailed June 15, 2004 setting a one-month period for reply. Applicants elect, with traverse, the claims of Group II.

Pursuant to 37 C.F.R. §§ 1.136(a) and 1.17(a), a one-month extension of the term for reply, i.e., to up to and including August 15, 2004 is requested. As August 15, 2004 fell on a Sunday, this response is being filed the following business day, Monday, August 16, 2004. The Commissioner is hereby authorized to charge \$110.00 in payment of the fee therefore, as well as any other required fee, or to credit any overpayment in fees, to Deposit Account No. 50-0320.

00211926

PATENT  
454313-2220.1

REMARKS

Reconsideration and withdrawal of the restriction requirement is respectfully requested in view of the remarks herein.

The Office Action requires an election from among:

- Group I: Claims 11 and 20, drawn to a DNA vaccine,  
classified in class 536, subclass 23.1; and
- Group II: Claims 21-25, drawn to methods of inducing an  
immune response, classified in class 435, subclass 5.

Applicants elect, with traverse, the claims of Group II.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “ [i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.*

Thus, for a restriction requirement to be proper, it must satisfy both of the above elements. Accordingly, the present restriction requirement is improper and must be withdrawn because the Office Action only alleges that the inventions are distinct, which allegation is traversed. The Office Action provides no showing that search and examination of the claims of Groups I-II would be an undue and serious burden. Therefore, the restriction requirement is improper because it does not satisfy both requirements for restriction.

It is also respectfully submitted that the present claims represent a web of knowledge and continuity of effort that merits examination in a single application. In order for the claims of Group II, elected herein with traverse, to be examined, a search will necessarily have to be undertaken which will also encompass the immunogenic compositions of the claims of Group I. Accordingly, any search will be coextensive and will not place an undue burden on the Examiner. Therefore, reconsideration and withdrawal of the Restriction Requirement are warranted and are respectfully requested.

In summary, enforcing the present restriction and election requirements would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, whereby a shortened patent term

00211926

PATENT  
454313-2220.1

may result in any divisional applications filed). Restriction has not been shown to be proper, especially since it has been shown that the requisite showing of serious burden has not been made. Indeed, the search and examination of each Group would be likely to be co-extensive and, in any event, would involve such interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner. All of the preceding, therefore, mitigate against restriction.

Consequently, reconsideration and withdrawal of the restriction requirement and election of species are respectfully requested.

Respectfully Submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for Applicants

By: Thomas J. Kowalski by Angela M. Collison  
Thomas J. Kowalski  
Reg. No. 32,147  
Angela M. Collison  
Reg. No. 51,107  
Tel. (212) 588-0800

00211926